

REMARKS

Claims 4 through 7, 9 through 15, 19 through 21, 24 and 25 are pending in this application. Claims 4 and 19 are amended in several particulars for purposes of clarity in accordance with current Office policy, to assist the examiner and to expedite compact prosecution of this application. The Applicant appreciates the Examiner's indication of allowability concerning claims 9 through 15 and 25.

I. CLAIM REJECTIONS - 35 U.S.C. § 102

Claims 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Dornier U.S. Patent 5,646,535. The Applicant respectfully traverse.

No claim is anticipated under 35 U.S.C. §102 (b) unless all of the elements are found in exactly the same situation and united in the same way in a single prior art reference. As mentioned in the **MPEP §2131**, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Every element must be literally present, arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (CAFC 1989). The identical invention must be shown in as complete detail as is contained in the patent claim. *Id.*, "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970), and MPEP 2143.03.

Concerning claim 19, the Examiner stated that Dornier discloses a method of displaying power-on self-test codes in a portable computer system, comprising the steps of displaying the power-on self-test code through an indicator when data inputted is a power-on self-test code (column 3, lines 59-63); and executing other interrupt routines when data is not a power-on self-test code (column 1, lines 57-61).

However, concerning claim 19 as amended, Dornier fails to disclose the selective display of the POST codes. In Dornier, there is no choice of displaying or not displaying the POST codes on the indicators when there the POST process starts while in claim 19. As mentioned for example, in col. 3, lines 59-63 of Dornier, there is simply a display.

Concerning claim 20, the Examiner stated that Dornier discloses the method of claim 19, with said indicator being a plurality of light emitting diodes, with each power-on self-test code corresponding to a specific light emitting diode on the portable computer (column 1, lines 62-66).

However, col. 1, lines 62-66 only states that there is a changing of the state combination of the LEDs, but there is no disclosure of a *each power-on self-test code corresponding to a specific light emitting diode on the portable computer*. In fact in col. 1, lines 41-51, there is the setting of on-off and color states of two or more LEDs in combination indicating the error. Therefore, clearly, one still has the problem of figuring out what is the combination to discern the code while in claim 20, each POST code corresponds to a specific LED.

As per claim 21, the Examiner stated that Dornier teaches the method of claim 20, with said

light emitting diodes sequentially aligned along a surface of the portable computer according to an order of operating states being tested by the portable computer, the alignment accommodating a rapid view of a progress of the power-on self-test (column 5, lines 15-19; column 2, lines 50-58).

Column 5, lines 15-19 and column 2, lines 50-58 only state that the LEDs can be implemented on the front of the panel and the types of LEDs. However, there is no disclosure of *light emitting diodes sequentially aligned along a surface of the portable computer according to an order of operating states being tested by the portable computer.*

II. REJECTION OF CLAIMS (35 U.S.C. § 103)

Claims 4-7, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dornier in view of Nanno et al. U.S. Patent 5,553,294.

According to MPEP 706.02(j), the following establishes a *prima facie* case of obviousness under 35 U.S.C. §103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the

reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

As per claim 4, the Examiner stated that Dornier discloses a portable computer system comprising of an indicating device having a plurality of light emitting devices activated according to a signal from the portable computer system (column 1, lines 44-50); and a controller managing said indicating device to display power-on self-test (POST) codes in response to operating states of the portable computer system, (column 1, lines 44-50; column 1, line 66 - column 2, line 4; column 3, lines 45-53) the power-on self-test codes being generated in power-on self-test process by a basic input-output system (BIOS) of the computer system (column 3, lines 45-53).

However, concerning claim 4 as amended, Dornier fails to teach or suggest the selective display of the POST codes in response to the operating states. As shown for example, in figures 4A-4C, the post codes are simply displayed on the two LEDs with different color combination for each code. There is no selection of whether there is a display.

The Examiner further states that although Dornier does disclose the operating states of a power on or off state, and an access state of a disk drive (column 2, lines 52-56), Dornier does not specifically teach the use of a number lock state, a capital lock state, a scroll lock state, and a charge

state of the battery. However, the Examiner explains that Nanno teaches the operating states comprising of a power on or off state, number lock state, a capital letter state, a scroll lock state, an access state of a disk drive, and a charge state of the battery (figure 5A; column 4, lines 55-59; column 5, lines 19-30) and that it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the operating states of Nanno to the system of Dornier and that one of ordinary skill in the art at the time the invention was made would have been motivated to utilize the operating states of Nanno to the system of Dornier because Nanno teaches the displaying of a plurality of states of objects in the computer system corresponding to state LED's (column 4, lines 55-59), such that this display is an explicit desire taught by Dornier (column 5, lines 15-23), wherein, Dornier teaches that more state LED's can be used to further enhance to inventive concept.

However, looking Nanno, in col. 4, lines 55-60 teaches only of the LEDs displaying the states. There is no teaching of having these LEDs in figure 5A being used for POST processing. The Examiner explains that Nanno gives the motivation of using more state LED's but there is no motivation shown to use Nanno's LEDs for the POST processing of Dornier.

As per claim 5, the Examiner explains that Dornier teaches the portable computer system of claim 4, with said indicating device being a plurality of light emitting diodes, with each power-on self-test code corresponding to a specific light emitting diode on the portable computer (column 1, lines 62-66).

However, col.1 62-66 to col. 2, lines 1-6 only states that the combination of the LEDs state *combination* are set according to the specific digital value. Therefore, clearly, Dornier fails to teach

that each POST code corresponds to a specific LED. In fact by stating that a combination of LEDs are needed to display the codes, there is a teaching away of having each POST code corresponding to a specific LED (singular LED, not plural as in Dornier). In the present invention, it is easier to discern the POST code while in Dornier, one has to use a map of key like in figure 5 showing the cumbersome template.

As per claim 6, the Examiner stated that Dornier teaches the portable computer system of claim 5, with said light emitting diodes sequentially aligned along a surface of the portable computer according to an order of operating states being tested by the portable computer, the alignment accommodating a rapid view of a progress of the power-on self-test (column 5, lines 15-19; column 2, lines 50-58).

Column 5, lines 15-19 and column 2, lines 50-58 only state that the LEDs can be implemented on the front of the panel and the types of LEDs. However, there is no teaching or suggestion of *light emitting diodes sequentially aligned along a surface of the portable computer according to an order of operating states being tested by the portable computer.*

As per claim 7, the Examiner stated that Dornier teaches the portable computer system of claim 6, with the light emitting diodes indicating where an error has occurred in the portable computer system (column 1, lines 41-50). However, since claim 7 depends on claim 6, as shown above, claim 6 is not taught or suggested by the combination.

As per claim 24, the Examiner states that it would have been obvious to one of ordinary skill

in the art at the time the invention was made to utilize the operating states of Nanno to the system of Dornier because one would be motivated to utilize the operating states of Nanno to the system of Dornier because Nanno teaches the displaying of a plurality of states of objects in the computer system corresponding to state LED's (column 4, lines 55-59). The Examiner states that this display is an explicit desire taught by Dornier (column 5, lines 15-23), wherein, Dornier teaches that more state LED's can be used to further enhance to inventive concept.

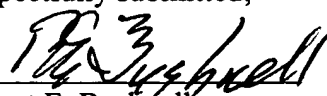
However, Nanno should not be combined with Dornier because there is no proper motivation to combine Nanno with Dornier. "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability. *In re Dembiczak*, 175 F.3d 994, 50 USPQ.2d 1614 (Fed. Cir. 1999). The showing must be "clear and particular" without broad generalized conclusory statements. *Id.* There must be specific statements showing the scope of the suggestion, teaching, or motivation to combine the prior art references. *Id.* at 1000. Col. 4, lines 55-60 teaches only of the LEDs displaying the states. There is no teaching of having these LEDs in figure 5A being used for POST processing. The Examiner explains that Nanno gives the motivation of using more state LED's but there is no motivation shown to use Nanno's LEDs for the POST processing of Dornier.

In view of the foregoing amendments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. If there are any questions, the

examiner is asked to contact the applicant's attorney.

No fee is incurred by this Amendment. Should there be a deficiency in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,


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